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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,642	05/30/2001	Ilia Zverev	IFT774US	8001

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EXAMINER

JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/867,642

Applicant(s)

ZVEREV ET AL.

Examiner

Hugh Jones

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Claims 1-8 of U.S. Application 09/867,642, filed 05/30/2001 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The detailed specification and figures disclose nothing more than generalities pertaining to the claimed invention. These generalities include downloading a standalone simulator and a vendor catalogue but disclose no specifics in a manner to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claims 1-8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

Art Unit: 2128

make and/or use the invention. The detailed specification and figures disclose nothing more than generalities pertaining to the claimed invention. These generalities include downloading a standalone simulator and a vendor catalogue but disclose no specifics in a manner to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In so far as there was no possession, the claims would require undo experimentation to derive the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

6. A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McDonald et al.

8. McDonald et al. disclose a standalone simulator (col. 23, lines 42-47):

Rather than receiving fees for only enhanced services, end users may provide fees for using basic services under the system. Furthermore, some or all aspects of the system may be sold or licensed as end-user software so that such end users may create and simulate circuit behavior, such as on a stand alone computer. Of course, various other revenue models are possible, as those skilled in the relevant art will recognize

9. McDonald additionally discloses:

Art Unit: 2128

A method of supporting an electronic component, which comprises: providing an online catalogue with electronic components; storing a computer-executable file with a standalone simulator for simulating a circuit behavior of a specific one of the electronic components; linking the computer-executable file to the specific electronic component in the online catalogue and enabling download of the computer-executable file to a consumer and enabling the consumer to execute a simulation with the specific electronic component (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37. It is also noted that no patentable weight is provided for "enabling" because the recitations are not required for the claim). Note col. 23, lines 42-47 and claim 30.

The method according to claim 1, wherein the storing step comprises archiving the computer-executable file and prompting the consumer to extract and install the computer-executable file prior to executing the simulation (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37.). Note col. 23, lines 42-47 and claim 30.

The method according to claim 1, which further comprises storing simulation models for the electronic components in the online catalogue and enabling the consumer to download either a simulation model or a standalone simulator linked to a given one of the electronic components (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37. It is noted that no patentable weight is provided for "enabling" because the recitations are not required for the claim). Note col. 23, lines 42-47 and claim 30.

A virtual product support system, comprising: a computer-readable file with a listing of electronic components; a storage system storing computer-executable files with standalone simulators for simulating an electronic behavior of the electronic components; a computer-readable file with a listing of the standalone simulators available in said storage system and with linking information between individual standalone simulators and individual electronic components; and a network connection for providing access to said listing of standalone simulators and for enabling download, by a customer, of individual simulators via said network connection (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37.). Note col. 23, lines 42-47 and claim 30.

The virtual product support system according to claim 4, wherein said network connection is an Internet connection and said listing of the standalone simulators is hyperlinked to said computer-executable files (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37). Note col. 23, lines 42-47 and claim 30.

Claim 6. The method according to claim I, which comprises the following steps, to be performed by a customer:

downloading the computer-executable file (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37); and executing the simulation with the specific electronic component in standalone mode (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37). Note col. 23, lines 42-47 and claim 30.

Art Unit: 2128

Claim 7. The method according to claim 6, wherein,

during the executing step, the customer is disconnected from a download site providing the computer-executable file (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37).

Claim 8. The virtual product support system according to claim 4, wherein the computer-executable files stored on said storage system are configured with computer-executable code designed, when executed on a standalone computer, to simulate an electronic behavior of a respective electronic component in standalone mode and without a real-time connection to a server (M: Fig. 1C; fig. 2A, fig. 13-14, fig. 16A, fig. 28-29. Note col. 11, lines 20-37, especially lines 34-37). Note col. 23, lines 42-47 and claim 30.

Response to Arguments

10. Applicant's arguments, filed 10/16/2006, have been carefully considered, but are not persuasive. Applicants are thanked for the amendment.

11. The 112 rejection is maintained. It is noted that Applicants have not in this response, or the response of 2/1/2005, actually referred to the specification in a showing of support, and instead rely upon allegation.

12. It would not require undo experimentation to write the code for the program/invention once the specific requirements and functionality of the code were known. However, it would require undo experimentation to derive the invention because no written description is provided in the specification for the claimed features. There is simply no information disclosing specifics.

Art Unit: 2128

13. MPEP section 2164.06(a) discusses enablement in view of "missing information" (emphasis added):

It is common that doubt arises about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation. In such a case, the examiner should specifically identify what information is missing and why the missing information is needed to provide enablement.

... See also *Union Pacific Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 57 USPQ2d 1293 (Fed. Cir. 2001) (Claims directed to a method of determining the location of a horizontal borehole in the earth failed to comply with enablement requirement of 35 U.S.C. 112 because certain computer programming details used to perform claimed method were not disclosed in the specification, and the record showed that a person of skill in art would not understand how to "compare" or "rescale" data as recited in the claims in order to perform the claimed method.).

... *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971), involved a method of facilitating transfers from one subset of program instructions to another which required modification of prior art "overlap mode" computers. The Board rejected the claims on the basis, *inter alia*, that the disclosure was insufficient to satisfy the requirements of 35 U.S.C. 112, first paragraph and was affirmed. The Board focused on the fact that the drawings were "block diagrams, i.e., a group of rectangles representing the elements of the system, functionally labelled and interconnected by lines." 442 F.2d at 991, 169 USPQ at 727. The specification did not particularly identify each of the elements represented by the blocks or the relationship therebetween, nor did it specify particular apparatus intended to carry out each function. The Board further questioned whether the selection and assembly of the required components could be carried out routinely by persons of ordinary skill in the art.

14. Applicant's arguments relating to the art rejections are moot in view of the new art rejections.

15. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

or

Art Unit: 2128

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)
or (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

March 10, 2007

